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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,528	07/21/2000	Andreas Muhlberger	PHO 99-534	4855

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BRIARCLIFF MANOR, NY 10510

EXAMINER

REVAK, CHRISTOPHER A

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/621,528

Applicant(s)

MUHLBERGER ET AL.

Examiner

Christopher A. Revak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. The examiner has found the amendments to independent claims 1 and 7 to overcome the prior art of record and are therefore allowable over the prior art. However, the examiner disagrees with the applicant's arguments that indicate the claims are allowable over the prior art for reasons of a "first and second voltage supply means, first and second clock generator, and first and second signal conversion means." The examiner has found these claims to be allowable over the prior art for different reasons, please refer to reasons for allowance as is recited below.

The examiner should note that it was determined that support was not found for certain limitations claimed by the applicant in independent claims 1 and 7, please refer to the rejection under 25 USC 112 first paragraph as is recited below as well.

2. Applicant's arguments filed September 24, 2004 have been fully considered but they are not persuasive. The applicant has amended independent claim 13 and has argued that Reiner et al does not teach "using the contents of the memory to be accessed in the determination of whether to permit that memory to be accessed." Independent claims 1 and 7 clearly recite of the distinction between accessing the different memory locations via the differing memory access means which are limited to certain storage locations and can access the other memory locations indirectly (please refer to reasons for allowance as is recited below), however that is not evidently clear in independent claim 13 of this feature. Reiner et al does disclose of "providing memory

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areas which can be accessed only through the first interface with contacts, and memory areas which can be accessed only through the contactless second interface", see column 2, lines 34-38. This is interpreted by the examiner to mean that the accessing is based on the stored data in the first storage location as is amended by the applicant. The examiner suggests amending independent claim 13 to include the limitations of independent claims 1 and 7.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-12 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. On lines 15-17 of claim 1 and lines 11-15 of claim 7 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. On page 9, lines 20-21 of the applicant's specification, it recites that the first memory means can only access the first storage location. It further recites second memory means can access the second storage location and the third storage location as is recited on page 12, lines 19 through 34. Furthermore, the second memory means can access the first storage location through the first memory means, see page 16, lines 21-32 and page 17, lines 9-23. This is only embodiment that the examiner could locate in the applicant's

specification, the examiner could not find where support is recited for the first memory means being able to access the "second storage location and not the third location" as is amended by the applicant.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Reiner et al, U.S. Patent 5,875,450.

As per claim 13, Reiner teaches of a method of accessing memory means of a data carrier having a first storage location (Figure 1, element 5) and a second storage location (col. 2, line 32). The method comprises the steps of storing data in the first storage location of the memory means (col. 2, lines 33-34). The first storage location is enabled to be accessed only by the first memory access means, characterized in that access authorizations for access to the first storage location are applied to the additional memory access means (col. 2, lines 64-65). Reiner et al does disclose of "providing memory areas which can be accessed only through the first interface with contacts, and memory areas which can be accessed only through the contactless

second interface", see column 2, lines 34-38. This is interpreted by the examiner to mean that the accessing is based on the stored data in the first storage location as is amended by the applicant. The applied access authorizations are verified with the aid of the additional memory access means (col. 3, lines 17-21) and in that after verification of the access authorizations and in the case of a positive verification of the first storage location is accessed additionally by a second memory access means via the additional memory access means and via the first memory access means (col. 4, lines 45-53). The examiner notes that a first memory access means (#3a,#3b,#3c) is between the first interface (#1) and memory means (#5) as shown in Figure 1. Also shown in Figure 1 is second memory access means (#7a,#7b,#7c) which is arranged between the second interface (#2) and the memory means (#5).

As per claim 14, Reiner et al teaches that in order for a communication device to be able to access protected memory, an authorization process must be performed first and successfully passed (col. 2, lines 64-65 and col. 4, lines 45-53). Reiner et al discloses that a user can carry out this procedure whereby the authentication procedure takes place in order to perform verification between the card and terminal or a user (col. 2, lines 63-65 and col. 4, lines 50-53). It is interpreted by the examiner that the access codes for comparison is computed and stored in memory since it is compared for verification.

As per claim 15, Reiner et al discloses of a first access condition must be verified in order to permit a user access to a protected memory (col. 2, lines 38-45). Reiner et al discloses that a user can carry out this procedure whereby the authentication

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procedure takes place in order to perform verification between the card and terminal or a user (col. 2, lines 63-65 and col. 4, lines 50-53). It is interpreted by the examiner that the access codes for comparison is computed and stored in memory since it is compared for verification.

***Allowable Subject Matter***

7. Claims 1-12 would be allowable if support can be indicated to overcome the rejection under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

It was not found to be taught in the prior art of a data carrier comprising first memory means having access to a first and second storage location, but not access to a third storage location. The data carrier also comprises second memory means has access to second storage location and a third storage location, but not access to a first storage location. Additional memory access means of the data carrier is adapted to cooperate with the second memory means and adapted to access the first storage location, verify an access authorization for access to the first storage location, and after verification that the second memory means is authorized, the second memory means accesses the first storage location via through both the additional memory access means and the first memory means.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Benhammou et al, U.S. Patent 6,094,724 discloses of a smart card containing user zones which require access control.

"New smart object based on MIFARE® PRO with bank-proven security" is a general teaching of dual interface IC that combines electronic ticketing with banking applications and electronic purses.


"Phillips Semiconductors introduces the first family of powerful high-security dual interface controller ICs for multi-service cards" is a general teaching of a dual interface multi-service card.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CR  
  
April 9, 2005

Christopher Revak  
AU 2131

  
4/9/05